Applicants submit that the Wagner reference does not disclose the pH at which the silane coupling composition is added to the rubber compound. Furthermore, the Wagner reference does not even remotely suggest adjusting the pH of the reaction mixture. Moreover, the Wagner reference does not recognize any reason or purpose for adjusting the pH. As such, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner reference by looking to the pH range disclosed in the Burns reference. See, *In re* Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989), wherein the Court found that "Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" Further, see, *In re* Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that "The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. See also, In re Stencel, 828 F.2d 751, 753, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) wherein the Court found that obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion that the combination be made." Moreover, in *Ex parte* Clapp, 227 USPQ 972, 973 Bd. Pat. App. & Int'f 1985), the Court found that "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. [S]implicity and hindsight are not proper criteria for resolving the issue of obviousness."

Applicants submit that in view of the above remarks, the claimed invention would not be obvious to one of ordinary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one of ordinary skill to combine the teachings of Wagner and Burns to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner and Burns references taken either alone or in combination.

In the aforementioned Office Action, the Examiner has provisionally rejected claims 1-18 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of copending Application No. 09/636,312. Applicants respectfully traverse this rejection. Applicants submit that the present invention is distinguishable from said copending patent application. The coupling agent of the present invention comprises a combination of (a) mercaptoorganometallic compound and (b) non-sulfur organometallic compound(s). The coupling agent of the copending application comprises a combination of (a) bis(alkoxysilylalkyl)polysulfide and (b) non-sulfur organometallic compound(s). Moreover, said copending patent application has the same file date as the present application (i.e., August 11, 2000), and each application claims priority to a provisional application filed on the same date (i.e., August 19, 1999).

Based on the foregoing remarks, Applicants submit that claim 1 and claims 2-18 which are dependent upon claim 1 of the aforementioned patent application are in condition for allowance, and reconsideration is respectfully requested.

Respectfully submitted,

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